UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,599	05/04/2005	Luis Carlos Sernan-Dez Arppe	P/189-375	7504

2352 7590 01/22/2009

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER	
KARIKARI, KWASI	
ART UNIT	**PAPER NUMBER**
2617	
MAIL DATE	**DELIVERY MODE**
01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/526,599	SERNAN-DEZ ARPPE ET AL.	
	Examiner	Art Unit	
	KWASI KARIKARI	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on 10/21/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-23 are rejected under U.S.C. 103(a) as being unpatentable over Gibson et al. (U.S. 6,775,249), (hereinafter Gibson) in view of Allison et al., (US 20030083078), (hereinafter, Allison).

Regarding claims 1 and 11, Gibson discloses a dialing error notification system (= local, regional, national and international network including fax and voice messaging facilities GIRAFF 220 and DISC 130 which operate to inform customer of a dialing error has occurred, see col. 4, lines 6-45 and Fig. 1) for telephony network (= users at a particular area make particular dialing errors, see col. 9,lines 1-12), the dialing error notification system comprising:

a first node (= apparatus 200 and GIRAFF 220; and monitoring of call to determine whether a valid destination has been specified, see col. 6, lines 14-63) of the telephony network comprising means apparatus for analyzing a number dialed by a subscriber and determining whether said dialed number complies with at least one predetermined error criterion (= GIRAFF analyzes dialing error, see col. 6, lines 14-63);

a first apparatus for determining the identity of the home mobile telephony network based subscriber (= DISC 130 receives international traffic; and the CLI capture facility operates to identify the identity of the number dialed by terminal 100, see col. 4, lines 45-58; whereby CLI is any information that accompanies an incoming call, e.g., the calling terminal's phone number), and

a second apparatus for sending a message (= sending of fax message to terminal 100, see col. 5, lines 21-27) with a dialing error notification to the subscriber if said dialed number complies with at least one predetermined error criterion (= international access code or country code is incorrect; and announcement informing customer that error has occurred, see col. 4, lines 33-45; col. 6, line 14- col. 7, line 53 and Fig. 4, steps 425 and 435); wherein the message is sent based on the determined identity of the home mobile telephony network (= the CLI capture facility operates to identify the identity of the number dialed by terminal 100; and sending of fax message to terminal 100, see col. 4, lines 45-58; col. 5, lines 21-27; whereby CLI is any information that accompanies an incoming call, e.g., the calling terminal's phone number).

Gibson explicitly fails to teach that the terminal 100 is "a visited subscriber in a visited network"; the sent fax message to the terminal 100 is "short message"; and the identiy of the terminal 100 is based on the International Mobile Subscriber Identity of the visiting subscriber.

However, **Allison**, which is an analogous art, mentions that the convergence of wireless communication networks and Internet data networks has introduced SMS notification services that include electronic email, Fax integration and Paging integration (see [0003-4]). Allison is also understood to teach the storage of subscriber's profile such IMSI,MIN,MDN,ISDN and MSISDN in both HLR and VLR; the production of routing information of a currently visiting subscriber; and the reception of short message at a recipient mobile station (see [0006, 0008, 0011, 0015, 0042, 0049-51 and 0055]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 2 and 12, as recited in claims 1 and 11, **Gibson** fails to teach said first node is a Service Control Point of the visited mobile telephony network".

However, **Allison,** which is an analogous art, teaches "said first node is a Service Control Point of the visited mobile telephony network" (see Pars. [0005,0039,0042-44]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 3 and 16, as recited in claims 1 and 11, **Allison** teaches a third apparatus for sending a message (M1) to an SS7-IP gateway from the first node, said message (M1) being a message with instructions to send the short message; a fourth apparatus for sending an http message to a short message sending server from said SS7-IP gateway, said http message being a message with instructions to send the short message; the second apparatus for sending the short message addressed to the visiting subscriber to a Short Message Service Centre of the visited network from said

short message sending server upon receipt of said instructions by said short message sending server (see Pars. [0047, 0067 and 0079] and Figs.7 & 9).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 4 and 17,as recited in claims 1 and 11, **Gibson** fails to disclose "apparatus for selecting text for the short message".

However, **Allison,** which is an analogous art, teaches "apparatus for selecting text for the short message" (see Pars. [0004, 0008, 0011 and 0015]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 5 and 18, as recited in claims 3 and 16, **Gibson** fails to discloses that the system is comprising the short message sending server includes a database with short message texts and an indicator code included in the http message received from the SS7-IP gateway"

However, **Allison,** which is an analogous art, teaches that the system comprises short message sending server that includes a database with short message texts and

an indicator code included in the http message received from the SS7-IP gateway" (see Pars. [0043, 0047, 0067 and 0079] and Figs.7 & 9).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 6 and 19, according to claims 3 and 16, **Gibson** fails to disclose a "data service such as short message service"

However, **Allison,** which is an analogous art, teaches "data service such as short message service" (see Pars. [0017, 0043,0047, 0067 and 0079] and Figs.7 & 9).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 7 and 20, as recited in claims 1 and 11, Gibson fails to disclose that "a fifth apparatus for sending an initial control set-up message to the first node, the initial control set-up message comprising at least the following data: the telephone number dialed by the visiting subscriber the mobile telephone number of the visiting subscriber and the International Mobile Subscriber Identity of the visiting subscriber"

However, **Allison,** which is an analogous art, teaches "a fifth apparatus for sending an initial control set-up message to the first node, the initial control set-up message comprising at least the following data: the telephone number dialed by the visiting subscriber the mobile telephone number of the visiting subscriber and the International Mobile Subscriber Identity of the visiting subscriber" (see [0006, 0008, 0011, 0015, 0042, 0049-51, 0055 and Figs.7 & 9).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Allison** into the system of Gibson for the benefit of achieving a system that provides short message service in a visited mobile network (see **Allison**; [0049-51]).

Regarding claims 8 and 21, as recited in claims 1 and 11, **Gibson** further teaches the apparatus for sending an initial control set-up message to the first node is comprised in the Mobile Switching Centre of the telephony network, such that when a subscriber in a cell corresponding to the Mobile Switching Centre dials a telephone number, said Mobile Switching Centre sends the initial control set-up message to the first node (receiving dialed number at Switching Center, see step 400 and Fig. 4a).

Regarding claims 9 and 22, as recited in claims 1 and 11, **Gibson** further teaches a control apparatus for preventing a message (a fax has been sent within the previous predetermined period, see col. 10, lines 16-25) with a dialing error notification from being sent to a subscriber if the time elapsed since a first message with a dialing error

notification was sent to said subscriber is less than a predetermined minimum time (see col. 9,line 64- col. 10, lines 35).

Regarding claims 10 and 23, as recited in claims 1 and 11, **Gibson** further teaches, wherein the error criteria include at least criterion selected from a group consisting of the following criteria:

- the number dialed begins with "+" followed by a sign different from a figure C, I/C x9;

- the number dialed begins with "00" followed by a sign different from a C, 1 <C /9;

the number dialed is in a 9- digit number beginning with a figure which is not 6, 7, 8 or 9,.- the number dialed begins with "+" or "00.' followed by a country code followed by an escape code not applicable for international dialing to said country; and

- the number dialed is a number with fewer than 9 digits which is not a short code (error may occur because some countries may have error in regional code or insufficient digitals in the number dialed, see col. 10, lines 59-62).

Regarding claim 13, as recited claim 11, **Gibson** further teaches, based on the identity home mobile telephony network of the subscriber as determined by the International Mobile Subscriber Identity of the subscriber, it is determined whether the subscriber has the right to a dialing error notification service (an inherent feature of services provided in Fig. 1, because checking whether a subscriber is entitled to receive a service prior to offering the service is common procedure in telecommunication network).

Regarding claim 14, as recited in claim 13, **Gibson** further teaching of system of GIRAFF and DISC 130 (see col.7, lines 44-61), meets the limitations of claim 14.

Regarding claim 15, as recited in claim 14, Gibson further teaching of system of GIRAFF and DISC 130 (see col.7, lines 44-61), meets the limitations of claim 15.

3. **Claim 24 is rejected under U.S.C. 103(a) as being unpatentable over Gibson in view of Allison in view of Lohtia et al., (U.S. 20030211845 A1).**

Regarding claim 24, according to claims 3 and 16, as the combination of **Gibson** and **Allison** fails to teach that the method is only carried out for visiting subscribers who are not provided with CAMEL service O-CSI flag.

Lohtia, which is an analogous art, teaches a GSM CAMEL messaging application (see Par. [0034]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of **Lohtia** into the system of Gibson and Allison for the benefit of achieving a system that includes SMS server to facilitate transmission of information to user device.

CONCLUSION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892 for cited references and the prior art made of record.

The Office action following a reopening of prosecution may be made final if all new grounds of rejection were either (A) necessitated by amendment or (B) based on information presented in an information disclosure statement under 37 CFR1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). In this case, the Final Office Action of 09/21/2007 has been withdrawn; the this current Final Office Action is based on the amendment filed on 07/12/2007.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of 33the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm).
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kwasi Karikari/
Patent Examiner: Art Unit 2617.

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617